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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,918	03/27/2001	Arthur M. Krieg	C1039/7048 (AWS)	4953
23628	7590	11/17/2004	EXAMINER	
WOLF GREENFIELD & SACKS, PC FEDERAL RESERVE PLAZA 600 ATLANTIC AVENUE BOSTON, MA 02210-2211			MINNIFIELD, NITA M	
			ART UNIT	PAPER NUMBER
			1645	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/818,918	Applicant(s) KRIEG ET AL.	
	Examiner N. M. Minnifield	Art Unit 1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-11 and 13-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-11 and 13-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) <u>5 sheets</u> | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/23/04; 8/30/04; 12/11/03 - 7 sheets total</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 23, 2004 has been entered.

2. Applicants' amendment filed August 23, 2004 is acknowledged and has been entered. Claims 2, 3 and 12 have been canceled. Claims 1, 4, 5, 10, 11 and 13-18 have been amended. New claims 19-30 have been added. Claims 1, 4-11 and 13-30 are now pending in the present application.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 4-11 and 13-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 19 of copending Application No. 10/817165. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim and disclose methods of treating dermatitis or allergic reactions comprising administering to the subject a composition comprising an immunostimulatory oligonucleotide or immunostimulatory and allergen.

It is also noted that Applicants have filed numerous related applications and that there could potentially be other double patenting rejections. Applicants are encouraged to apprise the Examiner of all applications that claim the same or similar subject.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. It is noted that all of the claimed sequences (SEQ ID NO: 37-40, 42-45) set forth in claim 10 have been examined.

6. Claims 1, 4-11 and 13-30 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method for treating asthma

(murine model) comprising administering to a subject in need of such treatment an immunostimulatory oligonucleotide (8-100 nucleotides long) comprising SEQ ID NO: 10, does not reasonably provide enablement for the ability to treat atopic dermatitis or allergic dermatitis comprising administering to a subject in need of such treatment any immunostimulatory oligonucleotide (8-100 nucleotides long) having the claimed formula as shown in claims 1 or 5, or the broad scope of the possible CpG-ODN that are envisioned in the formulas of claims 1 or 5. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to the invention commensurate in scope with these claims.

The claims are directed to a method of treating atopic dermatitis or allergic dermatitis comprising administering to a subject in need of such treatment a composition comprising a CpG oligonucleotide (8-100 or 8-40 nucleotides long) or a comprising a CpG oligonucleotide and allergen. The CpG oligonucleotide formulas are $X_1CG X_2$ or $X_1 X_2CGX_3X_4$. The claims, for example, define that X_1 , X_2 , X_3 , and X_4 are any nucleotide. The routes of administration have been defined as well as specific CpG sequences, SEQ ID NO: 37-40, 42-45.

The specification discloses Example 12 (see p. 51), prevention of the development of an inflammatory cellular infiltrate and eosinophilia in a murine model of asthma. Mice were immunized with *Schistosoma mansoni* eggs (SEA) by i.p. injection on days 0 and 7. SEQ ID NO: 10 was administered to the immunized mice and soluble SEA was administered by intranasal instillation on days 14 and 21. After challenge the mice were sacrificed and cytokine levels and other assays conducted on the lavage fluids. The specification indicates that Figures 9-15 show that CpG/SEA induced inflammatory cells, eosinophils, to be

present and generated macrophages; higher IL-12 was induced, IL-4 was reduced and IFN-gamma production increased. Applicants assert that the CpG redirected the cytokine response of the lung to production of IFN-gamma, indicating a Th1 type immune response (p. 52).

The specification does not teach that any of the other myriad of possibilities of CpG having the claimed formulas can be used to treat any form of dermatitis, atopic or allergic. The results shown for asthma do not indicate that the CpG will function in the same manner to treat atopic dermatitis or allergic dermatitis.

The state of the art is unpredictable with regard to treatments using CpG. CpG containing oligonucleotides are currently being investigated for exerting their immunotherapeutic effects in various organisms (See Krieg et al, Weiner and McCluskie et al for recent advances using CpG oligonucleotides). Biological responses to the administration of CpG containing oligonucleotides vary, however, depending on the mode of administration and the organism (See McCluskie et al in its entirety, and especially on page 296; see Krieg et al on page 524). Weiner states furthermore that the molecular mechanisms of CpG oligonucleotides' immuno-stimulatory effects are not yet understood (See especially page 461). And while the biological effects of some chemical modifications have been studied for CpG containing oligonucleotides, such as 2'-O-methyl modifications, phosphorothioate internucleotide linkages and 5-methyl cytosine substitutions, the incorporation and positioning of chemical modifications relative to the CpG dinucleotide are highly unpredictable (See Agrawal et al especially on pages 78-80; see pages 31-32 of the instant specification). Hussain et al 2004 also teaches that the "[C]ombined data from our studies with the murine model of allergic rhinitis and limited data from skin favor the idea that CpG ODN may be an attractive therapy in the treatment of

acute atopic dermatitis. On the other hand, chronic AD skin has significantly fewer IL-4 and IL-13 mRNA-expressing cells but higher numbers of IL-5, GM-CSF, IL-12, and IFN- γ mRNA expression than has acute AD skin (Leung, 1999). For that reason, the long-term benefits of treatment with CpG ODN remain speculative.” (see p. 27, col. 1). Further, Satoh et al teaches that CpG-ODN is responsible for worsening of allergic contact dermatitis. “S.c. applied Cpg ODN one day before sensitization of naïve mice significantly enhanced the ACD to DNFB which showed severe edema with massive CD8+ T cell infiltration.” (abstract) Satoh et al also teaches that “[T]hese results indicate that CpG ODN vaccinations may elicit and aggravate side effects such as harmful CD8+ T cell-mediated type IV hypersensitivity responses.” (abstract) Dziadzio et al teaches that “[V]arious combinations of plasmid DNA, immunostimulatory oligonucleotide (ISS-ODN), and proteins have been studied in murine models to evaluate the effectiveness of DNA vaccination. The success in skewing the immune response towards a Th1 phenotype in mice still needs to be evaluated in humans. The use of DNA vaccination as a treatment for allergic disease remains a viable option for the future.” (abstract) The state of the art, taken as a whole, is still unpredictable with regard to the use of ISS-ODN in treating atopic dermatitis or allergic dermatitis in a subject (human or otherwise) in need of such treatment.

The amount of direction or guidance presented in the specification and the presence or absence of working examples is a hindrance to practicing the claimed invention. Applicants have not provided guidance in the specification toward a method of treating the claimed atopic dermatitis or allergic dermatitis comprising the administration of any immunostimulatory nucleic acid comprising the formulas claimed in claims 1 and 5, for example. As previously stated the specification

teaches an increase in immunomodulation in mice (and comprising conversion from a Th2 to a Th1 immune response), and treatment of asthma in a mouse model comprising the administration of SEQ ID NO: 10. One skilled in the art would not accept on its face the examples given in the specification as being correlative or representative of the successful treatment of atopic dermatitis or allergic dermatitis in any organism comprising the administration by any route of any immunostimulatory nucleic acid comprising the formulas in claims 1 and 5 in view of the lack of guidance in the specification and known unpredictability associated with the ability to predict the biological effects exerted by CpG containing oligonucleotides in any and/or all organisms. The specification as filed fails to provide particular guidance which resolves the known unpredictability in the art associated with effects provided *in vivo* in any and/or all organisms upon administration via any route of CpG containing oligonucleotides, and further whereby treatment effects are provided in any and/or all organism for atopic dermatitis or allergic dermatitis. The breadth of the claims is very broad and the quantity of experimentation required is undue. The quantity of experimentation required to practice the invention as claimed would require the *de novo* determination of accessible target sites, modes of delivery and formulations of the CpG to target appropriate cells and/or tissues in any and/or all organisms, and further whereby treatment effects are provided for the claimed conditions. Since the specification fails to provide particular guidance for the treatment of the claimed atopic dermatitis or allergic dermatitis comprising administration by any route of any CpG containing oligonucleotide (claimed formulas), and since determination of these factors for a particular CpG containing oligonucleotide and for the particularly claimed conditions, route of administration and organism is

highly unpredictable, it would require undue experimentation to practice the invention over the broad scope as presently claimed.

The examples provided of the induction of various interleukins in spleen, liver or thymus cells are not representative of the successful treatment of any atopic condition (i.e. atopic dermatitis or allergic dermatitis) using any CpG containing oligonucleotide. No correlation is taught in the instant disclosure between the ability of these CPG containing oligonucleotides to induce a Th1 response in vitro (e.g. amount of IL-6 induction) and their ability to treat a representative number of atopic conditions (i.e. atopic dermatitis or allergic dermatitis) in vivo. An assumed common mechanism of action does not ensure enablement for treatment. Effective delivery to appropriate and concentration of a particular CPG containing oligonucleotide necessary for providing treatment effects for a particular CPG containing sequence are still highly unpredictable. The success of treating asthma with SEQ ID NO: 10 is not necessarily representative or correlative of the ability to successfully treat any atopic condition (i.e. atopic dermatitis or allergic dermatitis) with the generic sequences claimed. The in vivo treatment success for these generic sequences require undue experimentation beyond that provided in the instant disclosure.

The rejection is maintained for the reasons of record. Applicant's arguments filed August 23, 2004 have been fully considered but they are not persuasive. It is noted that Applicants arguments have been previously addressed, see above rejection.

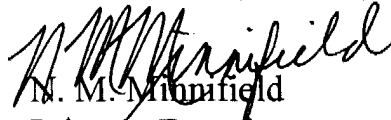
7. No claims are allowed.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. M. Minnifield whose telephone number is 571-272-0860. The examiner can normally be reached on M-F (8:00-5:30) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette R.F. Smith can be reached on 571-272-0864. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


N. M. Minnifield
Primary Examiner
Art Unit 1645

NMM
November 10, 2004